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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/679,054      | 10/03/2000  | Albrecht Dorschner   | Beiersdorf 656-KGB  | 4744             |

7590 07/08/2004  
NORRIS, MCLAUGHLIN & MARCUS, P.A.  
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30TH FLOOR  
NEW YORK, NY 10017

EXAMINER

LAMM, MARINA

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1616

DATE MAILED: 07/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/679,054

Applicant(s)

DORSCHNER ET AL.

Examiner

Marina Lamm

Art Unit

1616

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 15 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 5,7-11 and 16-19.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

Continuation of 3. Applicant's reply has overcome the following rejection(s): 102 (b) rejection of Claims 5 and 7-11 as being anticipated by Thomas et al..

***Double Patenting***

1. The provisional obviousness-type double patenting rejection of Claims 5, 7-11 and 16-19 as being unpatentable over claims 5-18 of copending Application No. 10/365,847 is maintained for the reasons of the record.

***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 5, 7-11, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al. in view of Moore et al.

Thomas et al. teach oil-in-water microemulsions containing 0.1-20% of ethoxylated glycerol-based non-ionic surfactants and 0.5-20% of insect repellents such as DEET (N,N-diethyl-m-toluamide). See Abstract; col. 4, lines 1-7; col. 5, lines 33-34. With respect to Claims 12 and 13, the microemulsions of Thomas et al. may contain anionic surfactants. See col. 6, lines 61-67; col. 7-8. The Thomas et al. reference does not teach the emulsifiers of the instant claims. However, the claimed emulsifiers are well known in the emulsion art and are conventionally used for the same art-recognized purpose as the ethoxylated glycerol-based non-ionic emulsifiers of Thomas et al., i.e. for the formation and stabilization of oil-in-water emulsions. Thus, Moore et al. teach employing cetareth-12 and cetareth-20 "to enable an emulsion to be formed when the oil and water phases are mixed". See col. 3, lines 49-52. Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention

Art Unit: 1616

was made to use cetareth-12 and/or cetareth-20 of Moore et al. for emulsions of Thomas et al. with a reasonable expectation of obtaining a stable oil-in-water microemulsion having the same or similar properties as set forth in the Thomas et al. reference. The selection of a known material based on its suitability for its intended use is obvious absent a clear showing of unexpected results attributable to the applicant's specific selection. See e.g., *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

4. The rejection of Claims 18 and 19 under 35 U.S.C. 103(a) as being unpatentable over Thomas et al. in view of Klier et al. (US 4,127,672) is maintained for the reasons of the record.

### ***Response to Arguments***

5. Applicant's arguments filed 6/15/04 have been fully considered but they are not persuasive. In response to the Applicant's argument that "[t]here is no indication in Thomas et al. that one of ordinary skill in the art could ignore their specific limitations and substitute an alternative emulsifier to obtain an oil-in-water emulsion which is able to accommodate an insect repellant," it is noted that the emulsifiers of Moore et al. (i.e. cetareth-12 and/or cetareth-20) are functionally and structurally similar to those of Thomas et al. and, therefore, are likely to affect hydrophobicity/hydrophilicity of the emulsion in the same manner as the ethoxylated non-ionic surfactants of Moore et al. Therefore, absent clear showing of unexpected results attributable to the selection of specific ethoxylated non-ionic surfactants, it would have been obvious for one skilled in the art to employ the ethoxylated non-ionic surfactants of Moore et al. in the

Art Unit: 1616

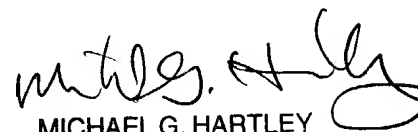
compositions of Thomas et al. with a reasonable expectation of deriving the same emulsion-stabilizing properties.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mon-Fri from 11am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached at (571) 272-0887.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
MICHAEL G. HARTLEY  
PRIMARY EXAMINER

ml  
6/30/04

